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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,573	09/19/2003	Michael John Sinclair	A01560 AECM/sd	8616
21898	7590	01/18/2006	EXAMINER	
ROHM AND HAAS COMPANY PATENT DEPARTMENT 100 INDEPENDENCE MALL WEST PHILADELPHIA, PA 19106-2399			ZEMEL, IRINA SOPJIA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/666,573	Applicant(s) SINCLAIR ET AL.	
	Examiner Irina S. Zemel	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 14, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

The restriction requirement is withdrawn in view of the applicants statement on the record that the claimed coating compositions are capable of being used together and drafting a claim linking all species of the claimed coating compositions. However, election of species, with powder coating species non-elected by original presentation as urged by the applicants on page 7 of their response in issued instead of the restriction requirement. Claims 14 and 17-18 are still withdrawn from consideration. In this regard, applicants should note that the claim status identifier for claims 14 and 17-18 is incorrect in the listing of claims provided in the last response.

While the examiner, upon her discretion, decided not to hold the submitted amended as non-compliant, appropriate status identifiers for all pending claims is required for all further submission to avoid issuance of "non-compliant amendment" action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-283621 to Hoechst AG, (hereinafter "Hoechst") in combination with either one of BASF technical Information Sheets for Leporal A 81 or Leporal A 101 of record (hereinafter "Leporal '81 or 101").

The rejection stands as per reasons of record.

Response to Arguments

Applicant's arguments filed October 27, 2005 have been fully considered but they are not persuasive.

The applicants should note that while the applicants address some alleged differences of the claimed invention and the invention disclosed in Hoechst in combination with BASF in the interview summary, the interview summary only presents the applicants' version of what was discussed during the interview. While the applicants' representative and the Examiner did discuss the invention and the alleged differences between the claimed invention and the teachings of the cited references, NO agreement was reached during the interview regarding such differences. Moreover, the Examiner advised the applicants' representative to reduce all of the arguments that are deemed to be pertinent and important in writing in discussion of the rejection. Therefore, the only arguments that the Examiner will address in the instant response are the arguments presented by the applicants on the record in the discussion of the rejection, i.e., the arguments presented on pages 8 and 9 of the applicants' response.

In this section the applicants argue that Hoechst reference fails to teach thermoplastic resin binder. The applicants also state that Hoechst reference further fails to teach any oxygenated heterocyclic thermoplastic resin, and any intumescent composition.

In response the examiner wishes to point out that she never alleged in the previously issued rejection the teachings of the Hoechst reference alone anticipate the

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claimed invention. The Examiner clearly recognized that the reference does not teach addition of the claimed thermoplastic binder (which, by the way, is the oxygenated heterocyclic thermoplastic resin for the elected species as per claim 1). For that reason the claimed invention was rejected over the combined teachings of two cited references. The applicants further state that Hoechst fails to teach any thermosetting resin as instantly recited (see second paragraph on page 8). This argument is, at best, is not understood. Applicants should note that, first of all, no thermosetting resin is recited in claim 1 (only a thermosetting binder). Thermosetting resin is recited in claim 5 (which, by the way, has no antecedent basis in the base claim 1), and the resin recited in claim 5 is an epoxy resin. Notably, the Hoechst reference clearly discloses thermosetting epoxy resins in the very first sentence relating to the disclosed invention (see paragraph 2 of the Abstract translation).

In the same paragraph the applicants further argue that the Hoechst reference fails to teach any resin proportions. Presumably, by "resin" the applicants mean thermoplastic binder, since it is the only one defined as "resin" (or "the oxygenated heterocyclic thermoplastic resin"). Of course the Hoechst reference fails to teach any proportions of such the oxygenated heterocyclic thermoplastic resin, since it does not teach this component at all.

The applicants further argue that none of the references provides the instantly proportion of the thermosetting binder. The applicants do not specifically point out where the deficiency of the Hoechst reference is and only generically state that no proportions of the thermosetting resin is disclosed. As far as the examiner is

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concerned, the Hoechst reference discloses, or at least makes obvious the claimed thermosetting binder proportions. The reference expressly states that the amount of the epoxy resin can be as low as 40 % by weight of the composition. In addition, the reference expressly states that the epoxy resin consists of epoxy resin ingredient AND a curing agent. See for example, claim 3 of the Hoechst reference. This means that 40 % by weight as disclosed in the reference refer to a combination of epoxy resin component that corresponds to the claimed component (b) and the curing agent corresponding to the claimed component (c). Since the reference does not specifically address the proportions of the epoxy resin compound and the curing agent, the reference implies that any proportions that will give adequate curing results are suitable for the invention. Further, in view of the examples where the amount of epoxy resin ingredient is roughly 2.5 -3 times greater than the amount of the curing agent, the claimed ranges of the components that correspond to the claimed components (b) and (c), are within the purview of the reference, or, at least, would have been obvious absent showing of unexpected results that can be clearly attribute to the claimed amounts of components (b) and (c).

The applicants further argue that there is no reason to combine the references provided anywhere within the teachings of the references. The examiner disagree. BASF references expressly states that the claimed oxygenated heterocyclic thermoplastic resin are known to be useful in epoxy-based composition to impart various desired characteristics, such as gloss, improved adhesion, etc., as discussed in the previous office action. The applicants argue that since the thermoplastic binder is

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reactive, it would have been a part of the flame proofing mixture. The Examiner can not see how the applicants arrive to this conclusion, since the oxygenated heterocyclic thermoplastic resin, as suggested by the rejection, is added to impart known characteristics to the epoxy-resin based composition that have very little to do with the flame proofing. But even, if, the applicants are correct in their assumption, the amount of the claimed oxygenated heterocyclic thermoplastic resin (or component (d)) can be as low as 5 weight %, and compositions resulting from adding or replacing 5 % of the flameproofing mixture of Hoechst with the oxygenated heterocyclic thermoplastic resin will still have the claimed ratios in view that the flameproofing mixture can be present in the compositions in the amounts of up to 60 %. One again, absent showing of unexpected result that can be attributed to the claimed amounts/proportions of the claimed components, (or at least some detailed explanations supported by the calculation that the claimed amounts clearly fall outside of the disclosed amounts) the examiner is of the opinion that the claimed invention would have been obvious from the combined teachings of the two cited references as per discussions above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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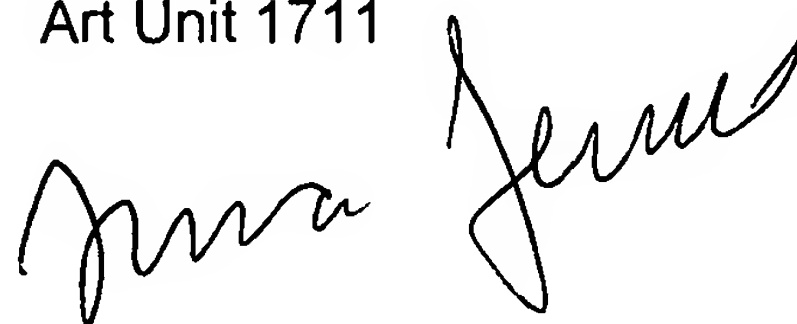
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel
Examiner
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